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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,576	03/22/2000	Peter W. Hamilton	7995	8660

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 06/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-131

Office Action Summary

Application No.

09/532,576

Applicant(s)

HAMILTON ET AL.

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-62 is/are pending in the application.
- 4a) Of the above claim(s) 58-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. §102 rejection of claims 1-4, 13 and 16 as anticipated by Blanc-Brude (5,906,883) of record in paper #11, pages 3-4, paragraph #3 has been withdrawn due to Applicant's amendment in paper #12.

REJECTIONS REPEATED

2. The 35 U.S.C. §103 rejection of claims 1-4 and 6-57 over Calhoun et al. (5,589,246) in view of Blanc-Brude (5,906,883) is repeated for reasons previously of record in paper #11, pages 4-6, paragraph #5.

Calhoun discloses an adhesive article used in a variety of applicants, such as in decorative and informative markings on vehicles; signage; buildings; fascia; awnings; taps, such as transfer tapes, double-sided tapes, photographic and other layout tapes; as well as masking tapes for paint spraying; wallpaper and the like (col. 6, lines 25-30). The adhesive article comprising a carrier film layer provided with a plurality collapsible protrusions with adhesive filling the non-raised region between the protrusions (col. 6, lines 41-60 and figure 1). The carrier can be made from polyolefins, such a high density polyethylene, low density polyethylene, and polyethylene copolymers (col. 8, lines 18-41). The projections can have any desired shape, dimension, and pattern. For example, they can be flattened on the top, convex, have a small concave indentation in the top to accommodate a small hole in the top to allow air bleed (col. 6, lines 54-60).

The size and shape of the recesses and projections in the embossed carrier web are not normally critical, but should be selected to match the intended application. The depth of the recesses is also not critically limited, but is normally less than 0.25 mm as are the thickness of the typical adhesives. The height of the projections must be larger than the thickness of the adhesive coated on the recessed surface portion. The three dimensional shape of the recesses and projections can easily be controlled if desired and tailored to specific applications. Cross-sections of the three dimensional shapes, which can be of a wide variety of shapes, including oval, circular, polygonal, or rectangular. See column 9, lines 7-19.

Although Calhoun does not explicitly teach the limitations a compressive force of at least about 0.5 psi to about 15 psi is required to collapse said protrusions or adhesive non-raised region having peel force of at least about 0.3 pounds per linear inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyolefins, more specifically, high density polyethylene) and in the similar production steps (i.e. embossing) used to produce the adhesive article. The burden is upon the Applicant to prove otherwise.

Calhoun discloses all the limitations of the instant invention except for a substrate on the back of the film layer.

Blanc-Brude discloses an adhesive sheet comprising a film having a front and back face, where the front face has a plurality of collapsible, non-adhesive protrusions extending outwardly from the front face and adhesive in the non-raised regions disposed between the protrusions (col. 2, lines 23-37 and figure 2). The adhesive sheet further comprises an external sheet (substrate), such as wall paper, bonded to the back face of the film (col. 2, lines 45-49). The film layer can

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be made of a thermoplastic material, cellulose paste, foam, polyurethane foam, vinyl or polyethylene (col. 3, lines 6-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add an external sheet, such as wall paper, as taught by Blanc-Brude to the adhesive article of Calhoun. One would be motivated to add the wall paper layer to Calhoun because it would add a decorative appearance to Calhoun, when Calhoun's article is used as wallpaper.

Since Calhoun discloses that the size and shape of the recesses and projections in the embossed carrier web are not normally critical, but should be selected to match the intended application, the exact number density of protrusions, protrusion height, protrusion center-to-center distance, base diameter, protrusion base surface area, and film thickness are deemed to be a cause effective variable with regard to the adhesion quality of the article. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as number density of protrusions, protrusion height, protrusion center-to-center distance, base diameter, protrusion base surface, and film thickness through routine experimentation in the absence of a showing of criticality in the claimed combined protrusion variables. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill would have been motivated to optimize these protrusion variables in order to match the intended application of the adhesive article, as taught by Calhoun in column 9, lines 7-19.

3. The 35 U.S.C. §103 rejection of claims 1-4 and 6-57 over Hamilton et al. (5,589,246) in view of Blanc-Brude (5,906,883) is repeated for reasons previously of record in paper #11, pages 7-9, paragraph #6.

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Hamilton discloses a flexible film coated with pressure sensitive adhesive for releasable sealing to a target surface, and more particularly premature sticking to a target surface during film positioning thereon (col. 1, lines 7-10). The composite film is useful in tapes, labels, and other articles using pressure sensitive adhesive to adhere an adhesive coated surface to a target surface (col. 1, lines 18-20). The composite film comprises a flexible film layer provided with a plurality collapsible conical shaped protrusions with adhesive filling the non-raised region between the protrusions (col. 5, line 64 to col. 6, line 13 and figure 10). The conical protrusions have a base diameter of about 0.015 inches to about 0.030 inches, a center-to-center spacing from 0.03 to 0.06 inches, and a protrusion height of about 0.004 inches to 0.012 inches (col. 6, lines 21-27). The preferred film material is 0.001 inch nominal thickness low density polyethylene (col. 6, lines 27-29). It is desirable to provide a stiffness, which is sufficient to withstand a pressure of 0.4 pounds per square inch without collapsing protrusions to where the adhesive contacts a target surface (col. 8, lines 2-5), which reads on requiring a compressive force larger than 0.4 pounds per square inch to collapse the protrusions.

Although Hamilton does not explicitly teach the limitations number density of protrusions or protrusion base surface area, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in that the protrusions have the same base diameter and center-to-center distance between the protrusions to make the composite film. The burden is upon the Applicant to prove otherwise.

Although Hamilton does not explicitly teach the limitation adhesive non-raised region having peel force of at least about 0.3 pounds per liner inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of

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similar materials (i.e. polyolefins, more specifically, polyethylene) and in the similar production steps (i.e. embossing) used to produce the adhesive article. The burden is upon the Applicant to prove otherwise.

Hamilton discloses the claimed invention except that the film is low density polyethylene instead of high density polyethylene. Calhoun in col. 8, lines 18-41, shows that low and high density polyethylene are equivalent materials in the art. Therefore, because these two materials were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute low density polyethylene for high density polyethylene.

Hamilton discloses all the limitations of the instant invention except for a substrate on the back of the film layer.

Blanc-Brude discloses an adhesive sheet comprising a film having a front and back face, where the front face has a plurality of collapsible, non-adhesive protrusions extending outwardly from the front face and adhesive in the non-raised regions disposed between the protrusions (col. 2, lines 23-37 and figure 2). The adhesive sheet further comprises an external sheet (substrate), such as wall paper, bonded to the back face of the film (col. 2, lines 45-49). The film layer can be made of a thermoplastic material, cellulose paste, foam, polyurethane foam, vinyl or polyethylene (col. 3, lines 6-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add an external sheet, such as wall paper, as taught by Blanc-Brude to the adhesive article of Hamilton. One would be motivated to add the wall paper layer to Hamilton because it would add a decorative appearance to Hamilton, when Hamilton's article is used for masking the wall.

ANSWERS TO APPLICANT'S ARGUMENTS

4. Applicant's arguments filed in paper #12 regarding the 35 U.S.C. §102 rejection of record have been considered but are moot since the rejection has been withdrawn.

5. Applicant's arguments filed in paper #12 regarding the 35 U.S.C. §103 rejections of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Blanc-Brude is silent with respect to the number density of protrusions. The Examiner agrees and has withdrawn the 35 U.S.C. §102 rejection as anticipated by Blanc-Brude. However, the 35 U.S.C. §103 rejections in view of Blanc-Brude does not rely on Blanc-Brude to teach this limitation.

Applicant argues that Calhoun is silent with respect to a requires number density of protrusions, but does disclose 36 protrusions per square centimeter (Calhoun example 1). Applicant states that 36 protrusions per square centimeter converts to approximately 5.5 protrusions per square inch. Applicant further argues that there is no suggestion in Calhoun to provide protrusions in Applicant's claimed ranges.

While the Examiner agrees that example 1 in Calhoun is outside of the Applicant's claimed limitation, it is noted that Calhoun also teaches that the size and shape of the recesses and projections in the embossed carrier web are not normally critical, but should be selected to match the intended application (see column 9, lines 7-19). Since these values are not critical and depend on the intended application of the adhesive article the exact number density of protrusions is deemed to be a cause effective variable with regard to the adhesion quality of the article. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as number density of protrusions through

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routine experimentation in the absence of a showing of criticality in the claimed combined protrusion variables. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill would have been motivated to optimize these protrusion variables in order to match the intended application of the adhesive article, as taught by Calhoun in column 9, lines 7-19.

Applicant argues that Hamilton is silent with respect to the number density of the conical protrusions disclosed. While the Examiner agrees with the assertion that Hamilton does not explicitly teach the number density of protrusions, as stated in the previous office action, “Although Hamilton does not explicitly teach the limitations number density of protrusions or protrusion base surface area, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in that the protrusions have the same base diameter and center-to-center distance between the protrusions to make the composite film. The burden is upon the Applicant to prove otherwise.”

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prime facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

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Therefore, it is inherent that Hamilton's flexible film has the same density of protrusions because the products are identical in structure and/or composition and there is no evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product.

Applicant argues that Blanc-Brude is silent with respect to the use of a substrate layer bonded to the back face of the film material. The Examiner disagrees because Blanc-Brude disclose the adhesive sheet further comprises an external sheet (substrate), such as wall paper, bonded to the back face of the film (col. 2, lines 45-49).

Applicant argues that Blanc-Brude, Calhoun, and Hamilton are silent with respect to Applicant's claim 21 limitation of requiring a peel force of at least about 0.3 pounds per linear. As previously stated, "although Calhoun does not explicitly teach the limitation an adhesive non-raised region having peel force of at least about 0.3 pounds per liner inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyolfins, more specifically, high density polyethylene) and in the similar production steps (i.e. embossing) used to produce the adhesive article. The burden is upon the Applicant to prove otherwise" and "although Hamilton does not explicitly teach the limitation adhesive non-raised region having peel force of at least about 0.3 pounds per liner inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyolfins, more specifically, polyethylene) and in the similar production steps (i.e. embossing) used to produce the adhesive article. The burden is upon the Applicant to prove otherwise."

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Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prime facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

6/6/03




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 6/6/03